



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/236,552	01/26/1999	WATARU TOMIDA	102654	1322

25944 7590 07/02/2002

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 07/02/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/236,552

Applicant(s)

TOMIDA, WATARU

Examiner

Joseph R. Pokrzywa

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-19,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-19,21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 23 April 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 10.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Applicant's amendments were received on 4/23/02 and 5/13/02, and have been entered and made of record. Currently, **claims 14-19, 21, and 22** are pending.

Response to Arguments

1. Applicant's arguments with respect to **claims 14 and 21** have been considered but are moot in view of the new ground(s) of rejection.

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 4/23/02 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Claim Objections

3. **Claim 22** is objected to because of the following informalities:
In **claim 22**, line 5, "an user" should read any one of "a user", "the user", or "said user".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 14-19, 21, and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudoh *et al.* (U.S. Patent Number 5,948,058) in view of Kulakowski (WIPO Publication Number WO 97/10668, cited in the Office action dated 1/30/02) .

Regarding **claim 14**, Kudoh discloses a **device** (electronic mail cataloging and retrieving system, seen in Fig. 1) comprising means for receiving **by the device via a network** (wide area network, column 12, lines 1 through 5) at least one set of electronic mail data attached with an electronic mail title (column 12, lines 43 through 49), means (display device) for displaying the electronic mail title that has been received along with the electronic mail data (see step 1302 in Fig. 13, column 13, line 62 through column 14, line 10), means (input unit 10) for selecting electronic mail data from the at least one set of electronic mail data based on the electronic mail title (column 11, lines 62 through 67), and means for forming an image based on electronic mail data selected by the data selecting means, wherein **the device** displays the received electronic mail title (column 12, lines 28 through 42).

However, Kudoh fails to particularly teach if the device is an **internet facsimile device**, which receives the electronic mail data via **an internet**. Kulakowski discloses an internet facsimile device (interface 26, see Figs. 1-3) comprising means for receiving by the internet facsimile device via an internet (page 8, lines 10 through 21) at least one set of electronic mail

Art Unit: 2622

data attached with an electronic mail title (being the text 86, seen in Fig. 4, page 14, lines 1 through 19, and page 18, lines 11 through 31), means (display 43) for displaying information that has been received along with the electronic mail data (page 18, lines 21 through 23), means (keypad 41) for selecting electronic mail data from the at least one set of electronic mail data based on the displayed information (page 18, lines 21 through 31), and means for forming an image based on electronic mail data selected by the data selecting means (page 18, lines 16 through 31), wherein the internet facsimile device (interface 26) displays the received electronic mail (page 10, lines 31 through 36). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kulakowski's teachings in Kudoh's system. Kudoh's system would easily be modified to include Kulakowski's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 15*, Kudoh and Kulakowski disclose the device discussed above in claim 14, and Kulakowski further teaches of including a second receiving means for receiving facsimile data via a public network (page 19, lines 18 through 36), and data converting means for converting the at least one set of the electronic mail data into facsimile data (page 20, lines 24 through 35), wherein the image forming means forms an image based on the facsimile data received via the public network and on the facsimile data converted from the at least one set of the electronic mail data (see Fig. 8, and page 18, lines 16 through 31). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kulakowski's further teachings in Kudoh's system. Kudoh's system would easily be modified to include Kulakowski's teachings, as the systems share cumulative features, being additive in nature.

Art Unit: 2622

Regarding **claim 16**, Kudoh and Kulakowski disclose the device discussed above in claim 14, and Kudoh further teaches of means for determining whether or not each one of the at least one set of electronic mail data has a high priority based on a corresponding electronic mail title (see Figs. 28-37, column 26, lines 4 through 48, and column 27, lines 32 through 51), and means for notifying the user of electronic mail data having the high priority (see Figs. 3, 6, 10, and 12, wherein the tray display area 72 includes a document symbol in the “Important” column).

Regarding **claim 17**, Kudoh and Kulakowski disclose the device discussed above in claim 14, and Kudoh further teaches of means for determining whether or not a priority of each one of the at least one set of electronic mail data is high based on a corresponding electronic mail title (see Figs. 28-37, column 26, lines 4 through 48, and column 27, lines 32 through 51), wherein the image forming means forms an image based on the electronic mail data which has been determined to have a high priority (see Fig. 29, column 26, lines 21 through 27).

Regarding **claim 18**, Kudoh and Kulakowski disclose the device discussed above in claim 17, and Kudoh further teaches of means for notifying a user when the image forming means forms an image based on the electronic mail data which has been determined to have a high priority (see Figs. 3, 6, 10, 12, and 29, wherein the tray display area 72 includes a document symbol in the “Important” column, and read in column 26, lines 21 through 27).

Regarding **claim 19**, Kudoh and Kulakowski disclose the device discussed above in claim 17, and Kudoh further teaches that the priority determining means determines that a priority is high when corresponding electronic mail title contains a predetermined character (see Figs. 28-37, column 26, lines 4 through 48, and column 27, lines 32 through 51).

Art Unit: 2622

Regarding *claim 21*, Kudoh discloses a method of controlling a *device* (electronic mail cataloging and retrieving system, seen in Fig. 1) comprising the steps of receiving electronic mail data attached with a header *by the device from a remote device* (column 12, lines 1 through 49), with the header including a title (column 13, line 62 through column 14, line 10), reading the title from the header (column 12, lines 43 through 49), displaying the title that has been received along with the electronic mail data (see step 1302 in Fig. 13, column 13, line 62 through column 14, line 10), and forming an image based on the electronic mail when requested by a user, wherein the internet facsimile device displays the received electronic mail title (see Fig. 18, column 12, lines 28 through 42, and column 15, lines 31 through 59).

However, Kudoh does not particularly teach if the method controls an *internet facsimile device*, therein receiving electronic mail data attached with a header *by the internet facsimile device from a remote internet facsimile device*. Kulakowski discloses a method of controlling an internet facsimile device (interface 26, see Figs. 1-3) comprising the steps of receiving electronic mail data attached with a header by the internet facsimile device from a remote internet facsimile device (from interface 10 through the Internet 20, page 8, lines 10 through 21, page 14, lines 1 through 19, and page 18, lines 11 through 31), displaying information that has been received along with the electronic mail data (page 18, lines 21 through 23), and forming an image based on the electronic mail when requested by a user (page 18, lines 16 through 31), wherein the internet facsimile device displays the received electronic mail (page 10, lines 31 through 36). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kulakowski's teachings in Kudoh's system. Kudoh's system would easily be

Art Unit: 2622

modified to include Kulakowski's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 22*, Kudoh and Kulakowski disclose the method discussed above in claim 21, and Kudoh further teaches of determining whether or not the electronic mail belongs to a predetermined group based on the title (see Figs. 28-37, column 26, lines 4 through 48, and column 27, lines 32 through 51), and notifying a user of an urgent mail when the electronic mail belongs to the predetermined group (see Figs. 3, 6, 10, and 12, wherein the tray display area 72 includes a document symbol in the "Important" column).

Citation of Pertinent Prior Art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Nada *et al.* (U.S. Patent Number 6,094,477) discloses an electronic mail terminal that downloads electronic mail and can display a title of the downloaded electronic mail;

Tanaka (U.S. Patent Number 5,765,178) discloses an electronic mail receiving system that allows the receiving party to control a display format of the received mail.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2622

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J.R.P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp
June 28, 2002

MaDeLine Nguyen

MADELINE NGUYEN
PATENT EXAMINER

AU 2622